

REMARKS

I. Introduction

Claims 5 to 8 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

II. Objection to the Drawings

As regards the objection to the drawings, Applicant does not agree with the characterization that "only that which is old is illustrated." Furthermore, the mention of Figure 1 in the section captioned "Background Information" does not render Figure 1 to be admitted prior art. Indeed, nothing in the Specification or Figures admits that Figure 1 illustrates "only that which is old." Accordingly, withdrawal of this objection is respectfully requested.

III. Rejection of Claims 5 to 8 Under 35 U.S.C. § 103(a)

Claims 5 to 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over that which the Final Office Action characterizes as "admitted prior art." As an initial matter, in addressing the merits of this rejection, Applicant does not concede the correctness of the Final Office Action's characterization of the subject matter of Figure 1 as prior art, but Applicant will proceed, for the sake of argument only, on the premise that the Final Office Action's characterization is accurate. Therefore, when framed accordingly, the argument of Applicant is that even if the Final Office Action is correct in characterizing Figure 1 as prior art -- which is not conceded -- the subject matter of claims 5 to 8 is still be patentable over Figure 1.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). Applicant respectfully submits that these criteria for obviousness are not met here.

Claim 5 recites "inserting signaling information, indicating whether the video object is to be decoded for playback or displayed, into the data stream one of before and after the time base information, regardless of an external form of the video object."

The Final Office Action states that "Applicant's claimed alternative embodiments of inserting the signaling information before or after the time base information" is "well known in the art that unless by shifting of insertion location produces novel and/or unexpected results, it is only considered as well known design option that is obvious to one of ordinary skill in the art because merely to shift location of a function call provides no significant functional or patentable differences." (Final Office Action, page 3). Applicant respectfully traverses these contentions to the extent that they are maintained and request that the Examiner provide specific evidence to establish those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because this rejection is apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). The admitted prior art does not describe inserting signaling information before the time base information. Hence, claim 5 is not render obvious because it recites inserting signaling information before or after the time base information.

Moreover, judicial or official notice that is based on subjective and unsupported reasoning will not sustain an obviousness rejection. In the M.P.E.P. cited case of In re Ahlert, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)), the Court made plain that:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. **Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 165 U.S.P.Q. at 420 to 21 (citations omitted).

Otherwise, if the Examiner cannot provide either references or an affidavit to support these contentions, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103 be withdrawn for this reason alone. Applicant previously traversed the Official Notice stated on page 4 of the Office Action dated

May 6, 2003. The present unsupported allegations of well-known fact substantially duplicate the previously traversed Official Notice. To date no published information or other evidence has been provided to support these entirely unsupported assertions. As stated in M.P.E.P. § 2144.03, “[i]f applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained” (emphasis added).

As regards the contention at page 4 of the Office Action that “it would have been obvious to one of ordinary skill in the art at the time the invention was made, to exploit the common knowledge of inserting signaling information in the processing method of Applicant’s admitted prior art,” the Examiner’s attention is directed to the recent Federal Circuit decisions of In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) and In re Zurko, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001), which found that deficiencies of cited references could not be remedied by general conclusions about what is “basic knowledge” or “common sense.” In re Lee, 61 U.S.P.Q.2d at 1435 (common knowledge and common sense do not substitute for authority when the law requires authority; when an examiner and the Board rely on what is asserted to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record; final rejection reversed); In re Zurko, 59 U.S.P.Q.2d at 1697 (assessment of basic knowledge and common sense that was not based on any evidence in the record lacks substantial evidence support; final rejection reversed).

Additionally, Applicant respectfully submits that inserting the signaling information before the time base information instead of after the time base information is not simply a matter of design option. Rather, as stated at page 3, lines 12 to 17 of the Specification, for example, “[i]f the signaling information is inserted before the local time base information, even less data need be transmitted for a non-coded VOP than when the signaling information is inserted after the local time base, because in this case the local time base information is not transmitted.”

In view of the above discussion, Applicant respectfully submits that the “admitted prior art” does render obvious claim 5. Claims 6 to 8, which depend from claim 5, are similarly allowable by virtue of their dependence on allowable claim 5.

In view of the foregoing, it is respectfully submitted that the present rejection has been obviated, and withdrawal of this rejection is therefore respectfully requested.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Richard L. Mayer

Dated: 3/23/04

By: May L. Werner Reg No 30,333
Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

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